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Remarks/Arguments

Claims 1, 3, and 5-28 are pending in this application. No claims have been amended. Claims 1, 3, and 5-28 will still be pending after entry of this response. Applicant believes no additional fee is due.

Applicant notes that the Examiner's most recent action is non-final, and appreciates the Examiner's willingness to remain open to arguments and/or amendments with respect to the present application. However, Applicant respectfully disagrees with the Examiner's statement that the Applicant has removed a significant part of the invention from the claims. Specifically, the Examiner has stated in paragraph 1 of his office action that the previous amendment resulted in a "most significant part of the invention" being "taken out from the claims," referring to the word "atomically" or presumably variations of that word. Applicant submits that his claims have not been changed in any legally meaningful way with respect to the use of this term. As discussed in the March 12th interview, and Applicant's previous interview summary, the word "atomically" was replaced in Applicant's claims by its definition from Applicant's specification, that is, "without suspending task execution" or the like. Such a change amounts to making extrinsic what was already intrinsic in the claim language, that is, the definition of a specific term as used by the Applicant. See *Bose Corp. v. JBL, Inc.*, 61 USPQ2d 1216 (Fed Cir. 2001). Thus, if the Examiner had an opinion on patentability that was predicated in some way on the recitation of the word "atomically" in the claims, that opinion should not have changed because of Applicant's amendment to replace that term with its definition. If the Examiner is now of the opinion that changing the definition now recited in the claims back to the word "atomically" would aid Applicant in procuring a favorable disposition of his Application, the Applicant will be happy to entertain this possibility.

In the recent office action, the Examiner has rejected claims 1, 8-9, 13 and 15-28 under 35 USC § 103(a) as being unpatentable in view of U.S. Patent 6, 449,614 to Marcotte in combination with U.S. Patent 5, 623,666 to Pike et al. The Applicant respectfully disagrees with the Examiner's characterization of this art and the Examiner's application of this art to Applicant's claims. In order to establish the obviousness of a claim, the Examiner must show that all of the claim limitations must be taught or suggested by the prior art. M.P.E.P.

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2143.03. Furthermore, the prior art must suggest the desirability of the claimed invention. That is, the nature of the problem to be solved or the teachings for the prior art must cause a motivation to combine references. MPEP 2143.01. The Examiner's position fails both of these requirements.

With respect to finding the Applicant's claim limitations in the prior art, the Examiner has turned to Marcotte for most of these limitations. Marcotte describes the locking of resources or files within an operating system that supports access by multiple users. Thus, the operating system provides a facility to lock files and applications from other users when a user needs to be the sole holder or user of access to a file or application. There is no discussion in Marcotte of file look-up operations or namespace caches as referred to or discussed in Applicant's claims. The Examiner appears to have picked out specific sections of the Marcotte patent and made only conclusory statements as to their disclosure of the limitations in Applicant's claims. For example, with respect to claim 1, 8, 13, and 23, the Examiner has cited Marcotte, col. 18, lines 26-33, against Applicant's preamble language about handling requests to perform a file operation relative to a specific file. However, the cited section of Marcotte deals with I/O events and devices, it has nothing to do with file operations as disclosed and claimed in the present application.

With respect to all of Applicant's independent claims listed in the 103 rejection, the Examiner cites col. 14, lines 5-18 of Marcotte against the limitation of attempting to perform a file operation without suspending task execution. The cited portion of Marcotte is discussing an asynchronous update mechanism to queue I/O requests. Furthermore, this is done with respect to locking. These disclosures in Marcotte have nothing to do with performing file operations without suspending task execution. Locking, as disclosed in Marcotte, has nothing to do with the suspension of task execution as discussed and claimed in applicant's invention.

Further, with respect to claims 1, 8, 13, 15, and 23, all of the independent claims in the 103 rejection, the Examiner cites col. 18, lines 26-33 of Marcotte. This portion of Marcotte discusses caching tokens for SMB clients. SMB in Marcotte appears to refer to "sequential message block" networking protocol (used for Windows file sharing, among other things) and tokens having to do with accessing files by clients over a local area network using this protocol. The Examiner cites this section of the Marcotte patent against Applicant's claim limita-

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tions having to do with looking up or determining file path information in a file system namespace cache. This portion of Marcotte and these limitations in Applicant's claims are completely disjunct. Tokens are not file paths and a token cache is not even remotely related to a namespace cache. Applicant's independent claims 1, 8, 13, 15 and claim 23 are patentable for at least the above reasons.

The Examiner admits that Marcotte does not disclose the "namespace cache" that is recited in Applicant's claims. The Examiner then looks to the Pike patent for disclosure of the concept of a namespace cache. Although Pike mentions a "namespace," it is completely silent on the concept of a namespace cache. There are limitations related to and specifically reciting a namespace cache in all of Applicant's claims 1, 8, 13, 15, and 23, and there is no concept of a namespace cache mentioned in either the Pike or Marcotte patents. The Examiner at several places in the office action refers to the Applicant's namespace as a "namespace for cache," which it is not. The namespace does not contain a cache, but rather file paths that can be mapped to file descriptor ID's. The namespace cache, sometimes colloquially referred to as a "dentry cache" can cache some of this information. The namespace does not contain the cache, rather, it is the other way around.

Applicant notes that since, based on the above arguments, all of the independent claims rejected under 103 are patentable, that all of the dependent are then patentable for at least the same reasons. However, with respect to claim 3, the Examiner points to Marcotte as teaching that a filesystem namespace cache can be disposed within an operating system kernel. Since by the Examiner's own admission, Marcotte does not teach the namespace cache, this is impossible. However, even in combination with Pike, such a namespace cache is not disclosed, as previously discussed. The same argument applies to claim 9.

With respect to dependent claims 18, 19, 20, 21, and 22, the Examiner again cites Marcotte as teaching limitations which are related to what happens when file operations cannot be performed without suspending task execution. Again, the sections of Marcotte referred to have to do with local area network client tokens and asynchronous updating to queue I/O operations. Again, the limitations of Applicant's claims and the cited sections of Marcotte are completely disjunct. All of the other dependent claims cited in the Examiner's 103 rejection,

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again, are patentable for at least the same reasons discussed above with respect to the independent claims.

While the fact that so many limitations in Applicant's claims cannot be found in the cited art should be dispositive as to the patentability of the present claims, the Applicant would also like to respectfully point out that the Examiner has failed to show a motivation to combine these references. Both the teaching and a reasonable expectation of success must be found in the prior art, not in the Applicant's disclosure. Where no express teaching or suggestion is apparent from the references, the Examiner must establish, with evidence or reasoning, why one skilled in the art would have been lead to the relevant teachings of the applied references to make the proposed combination. See *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). The Examiner has simply supplied conclusory statements using some of the technical language from the cited references. As previously discussed, the portions of the prior art the Examiner cites refer to a token cache, not a namespace cache. Thus, even combining the token cache with the teachings of Pike would not result in an operable combination that is even remotely like the Applicant's invention, therefore motivation is lacking.

In paragraph 5 of the office action, the Examiner has rejected claims 5-7, 10-12, and 14 under 35 USC § 102(e) as being anticipated by the Marcotte patent. It is axiomatic that, in order for a claim to be anticipated, the cited reference must teach every element of the claim, either expressly or inherently. M.P.E.P. 2131. The Examiner relies on much of the same disclosure in Marcotte to anticipate the claims rejected under 102 as he did to anticipate elements of the claims rejected under 103. The Examiner looks to col. 14, lines 5-13 for disclosing limitations related to performing a file operation without suspending task execution. This portion of Marcotte discusses an asynchronous update mechanism to queue I/O, it has nothing to do with file lookups of any kind. Again, for the preamble language, the Examiner cites col. 13, lines 50-60, which again deals with I/O events and devices. The teachings of Marcotte and Applicant's claims are, again, completely unrelated.

With respect to dependent claims 6, 7, 11, and 12, the examiner cites col. 6, lines 47-55 of Marcotte. These claims add limitations relative to blocking point handling. The section of Marcotte cited discusses locking files so that they cannot be accessed by additional clients in a client server system operating on a local area network. The term "locking" and the term

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"blocking" are completely unrelated. Thus, these dependent claims are patentable for this reason, in addition to the reasons cited above with respect to the independent claims.


Applicant believes he has responded to all of the concerns raised by the Examiner. Reconsideration of this application is hereby requested. If the Examiner has any questions about the present response, a telephone interview is requested.

The Examiner is authorized to charge any fees required and not paid herein, or credit any overpayment to Deposit Account 13-4365.

Respectfully submitted,

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Telephone: (919) 286-8000
Facsimile: (919) 286-8199


Steven B. Phillips
Attorney for Applicant
Registration No. 37,911
Moore & Van Allen PLLC
Suite 800
2200 West Main Street
Durham, NC 27705